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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/411,521    10/04/99    KOSHKARIAN    K    98-639

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QM02/0804

EXAMINER

JEFFERY, J

ART UNIT

PAPER NUMBER

3742

*4*

DATE MAILED: 08/04/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/41521

Applicant(s)

Koshkarian et al

Examiner

Jeffery

Group Art Unit

3742

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-14 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 1-14 are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

Restriction to one of the following inventions is required under 35 USC 121:

- I. Claims 1-12 and 14, drawn to a silicon-based component, classified in Class 219, subclass 270.
- II. Claim 13, drawn to a process for coating a silicon-based component, classified in Class 427, subclass 126.1.

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process such as a wide variety of coating methods not necessarily involving (1) increasing the temperature of the component above 1110 degrees C from 6-12 hours (2) forming a silica layer and then (3) creating a reaction with the silica layer.

If invention I is elected pursuant to the requirement above, then Applicant is subject to the election of species requirement below:

This application contains claims directed to the following patentably distinct species of the claimed invention I:

Species A: Silicon-based component is silicon nitride with rare earth silicate coating

Species B: Silicon-based component is silicon carbide with rare earth silicate coating

Species C: Silicon-based component is molybdenum disilicide with rare earth silicate coating

For either Species A, B, or C elected above, Applicant must further elect a single disclosed subspecies of Species A-C as outlined below:

Subspecies 1: Rare earth silicate coating is ytterbium silicate

Subspecies 2: Rare earth silicate coating is lanthanum silicate

Subspecies 3: Rare earth silicate coating is yttrium silicate

Furthermore, for either Species A-C and subspecies 1-3, Applicant must further elect a single disclosed sub-subspecies of the claimed invention as outlined below:

Sub-subspecies I: Silicon-based component is a glow plug

Sub-subspecies II: Silicon-based component is a turbocharger

Sub-subspecies III: Silicon-based component is a turbine blade

In summary, if Invention I is elected above, Applicant must elect one disclosed species, one subspecies, and one sub-subspecies from each group as outlined above.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, subspecies, and sub-subspecies from each group as outlined above for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 8, and 9 are generic.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a generic claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP 809.02(a).

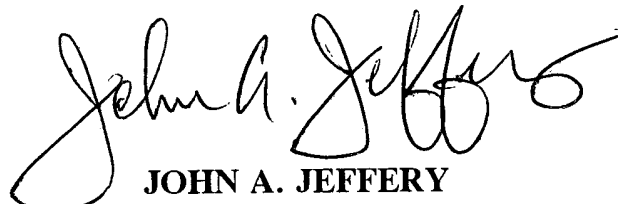
Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103 of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more

of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

Any inquiry concerning this or earlier communications from the examiner should be directed to John A. Jeffery at telephone number (703) 306-4601 or fax (703) 308-7764. The examiner can normally be reached on Tuesday-Friday from 7:00 AM to 5:30 PM EST.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 3700 receptionist whose telephone number is (703) 308-0861.

  
**JOHN A. JEFFERY**  
**PRIMARY EXAMINER**  
**ART UNIT 3742**

08/03/00